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09/891,806	06/26/2001	Yong Jin Chang	858-11 CIP	2661

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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,806

Applicant(s)

CHANG ET AL.

Examiner

David C. Comstock

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18 and 20 is/are rejected.
- 7) ☒ Claim(s) 16 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Korea on 27 June 2000. It is noted, however, that applicant has not filed a certified copy of the Korean application as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Nail Max 2000 (cited by applicant).

Nail Max 2000 discloses a "Sparkled White French Nail" having an artificial nail with a nail body comprising a bed portion, a tip portion, and a dividing line between the bed portion and tip portion (see figure at page 81 near top right). From the figure, the dividing line appears to correspond to the transition of a natural nail from bed to tip. The nail bed portion appears to correspond in size and shape to the nail bed of a natural fingernail. The nail tip is painted with a continuous opaque decoration, i.e., white. The translation of the figure discloses and/or suggests that the material of the nail body is

"clear," which is synonymous to transparent. Moreover, "clear" is defined by the *Webster's II New Riverside University Dictionary, The Riverside Publishing Company 1994*, as "Free from clouds, mist, or haze, " "Free from what dims, obscures, or darkens: TRANSPARENT." The nail body further includes decorative designs over the body. The decorative designs look like glitter.

Claims 1, 3, 7, 8, 10, 14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Mast et al. (4,751,935).

Mast et al. disclose an artificial nail and an artificial nail tip comprising a body made from a transparent plastic material (see Figs. 1, 4, and 5; col. 3, line 62 - col. 4, line 5; col. 4, lines 41-48; col. 5, lines 1-2; col. 5, line 65 - col. 6, line 2; and col. 6, lines 47-57). The body has a nail bed portion 1,1' corresponding to a natural nail bed or distal end thereof (in the case of embodiment 1') and a nail tip portion 2, 2' corresponding to a natural nail tip. The junction of these two portions defines a dividing line. The nail tip portion 2,2' includes a continuous opaque decoration, i.e., the roughened light diffuser, that obscures the natural nail tip. The artificial nails are applied to natural nails with conventional nail adhesive. A transparent sealer is applied over the artificial nail. (See col. 5, lines 16-23.)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mast et al. (4,751,935) in view of Agee, II et al. (D380,867).

Mast et al. discloses the claimed invention except for the dividing line at an angle. Agee, II et al. disclose a similar device having a dividing line at an angle relative to the natural dividing line to provide a decorative appearance and enhance the ornamental appearance of the nails (see Fig. 1, Title, and Claim). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail and tip of Mast et al. with a dividing line oriented at an angle relative to the natural dividing line, in view of Agee, II et al., in order to provide a decorative appearance and enhance the ornamental appearance of the nails.

Claims 8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant on PTO-1449) in view of Mast et al. (4,751,935).

Nail Max 2000 discloses the claimed invention except for the nail base (as opposed to the nail bed). Mast et al. discloses that artificial nails comprising nail *beds* (corresponding to the natural nail bed) and nail tip portions and those comprising nail *bases* (corresponding the the distal end of a fingernail) and nail tip portions are functionally equivalent structures, known in the art, for decorating fingernails (see Figs. 1, 4, and 5 and col. 6, lines 47-57; also see Nakata et al. [4,615,348] at col. 1, lines 29-34 and Wood [5,704,375; cited by applicant]). Therefore, since these two nail decorations were functionally equivalent structures known in the art at the time of the invention, it would have been obvious to a person of ordinary skill to substitute artificial nails comprising nail bases and nail tip portions for artificial nails comprising nail beds

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and nail tip portions, as such is merely the substitution of functionally equivalent nail decorations.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mast et al. (4,751,935) in view of Bartolucci ( 3,982,551; cited by applicant).

Mast et al. disclose the claimed invention except for the kit. Bartolucci discloses a kit 10 comprising artificial fingernails 14 and adhesive 50 (see Fig. 1). The kit makes the nails easier to use and provides the nails and necessary supplies in an aesthetically attractive, compact, complete, and ready-to-use manner (see col. 1, lines 1-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nails of Mast et al. in a kit, in view of Bartolucci, in order to make the nails easier to use and to provide the nails and necessary supplies in an aesthetically attractive, compact, complete, and ready-to-use manner.

Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mast et al. (4,751,935) in view of Ferrigno ( 4,450,848; cited by applicant).

Mast et al. disclose the claimed invention except for the transparent acrylic filler. Ferrigno discloses an artificial fingernail forming method comprising applying a transparent filler having an acrylic powder along with a liquid cyanoacrylate adhesive rearward of the tip, allowing the combination to harden, and buffing it. This allows the artificial nail to remain on the natural fingernail longer and increases the potential market for the device, i.e., to men etc. (see col. 1, lines 15-29 and 42-53 and col. 2, Examples). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail applying method of Mast et al. with a

step of applying an acrylic filler composed of powder and liquid cyanoacrylate, in view of Ferrigno, in order to allow the artificial nail to remain on the natural fingernail longer and increase the potential market for the device.

***Allowable Subject Matter***

Claims 16 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

OC

D.C. Comstock  
17 September 2003

  
EDUARDO C. ROBERT  
PRIMARY EXAMINER